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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,515	12/07/2000	Joseph C. Eder	8600-0008	2423

20855 7590 01/29/2003

COOLEY GODWARD LLP (R&P)
FIVE PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA 94306-0663

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT PAPER NUMBER

3738

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,515

Applicant(s)

EDER ET AL.

Examiner

Corrine M. McDermott

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 7/22/02 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it lacks the fee set forth in 37 CFR 1.17(p) **or** it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Information disclosure statements filed after 1st office actions but prior to final action or allowance are only considered if a \$180.00 fee is paid **or** a certification under 1.97(e) is made.

DETAILED ACTION

Drawings

The corrected or substitute drawings were received on 11/13/02. These drawings are acceptable.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,5,6,10 are rejected under 35 U.S.C. 102(e) as being anticipated by Camrud et al. '117. Figs. 1A, 2A, and 8A illustrate a stent or coil that have a plurality of detachment junctions which result in cleaved portions shown in Figs. 1B,2B and 8B respectively. Since the end products are the same as the claimed device, the junctions are inherently capable of being cleaved by a different wavelength of electromagnetic radiation.

Claims 1-7,10,11,13,15,16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. '599. Lee discloses that the device can be a stent, coil, etc. of which is released from a catheter via a delivery mechanism, col. 1, lines 19-24. Lee also discloses to use a shape memory polymer (col. 3, lines 11-15) and the plurality of detachment members inherently having detachment junctions are cleaved using electromagnetic radiation, such as light or fluid (col. 3, lines 24-31). Since the end products are the same as the claimed device, the junctions are inherently capable of being cleaved by a different wavelength of electromagnetic radiation.

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Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. '599. Lee is explained supra. However, Lee does not disclose the light is visible or non-visible. It would have been an obvious matter of design choice to modify the type of light used, since applicant has not disclosed that using visible light or non-visible light provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any light, such as the light taught by Lee or the claimed light of claims 8 or 9 because all light provides radiation to the junction and perform the same function of cleaving the junction.

Claims 12, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. '599 in view of Maitland et al. '917. Lee is explained supra. However, Lee does not disclose a transmitting device in the form of fiber optic cables or laser as a light source. Maitland teaches that laser energy via an optical fiber can be applied to an SMP to release an object from a catheter system, col. 2, lines 59-65. It would have been obvious to one of ordinary skill in the art to use laser light to provide radiant energy as taught by Maitland in the system of Lee in order to separate detachment members such that when the junction is cleaved, energy is removed.

Response to Arguments

Applicant's arguments filed 11/13/02 have been fully considered but they are not persuasive. In response that neither Lee nor Camrud disclose the method limitation "cleaved by

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different wavelengths of electromagnetic radiation" it first must be noted that the claims are product or apparatus claims. Secondly the claims have been rejected under the interpretation that the method limitation or functional wherein clause has not been given much weight since MPEP 2113 states that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In this case the end products are the same.

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

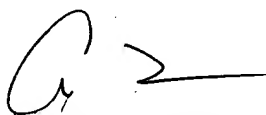
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino

January 16, 2003

TC 3700, AU 3738



CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700